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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,524	09/19/2000	Jean-Francois Le Pennec	909.0029USU	5842

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EXAMINER

LAFORGIA, CHRISTIAN A

ART UNIT PAPER NUMBER

2131

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/665,524

Applicant(s)

LE PENNEC ET AL.

Examiner

Christian La Forgia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 December 2004 has been entered.
2. Claims 1-17 have been presented for examination.
3. Claims 2 and 3 have been cancelled as per Applicant's request.

### ***Response to Arguments***

4. Applicant's arguments, see the last paragraph of page 10, the first paragraph of page 11, and page 12, filed 09 December 2004, with respect to claims 1 and 4-17 have been fully considered and are persuasive. The rejection of claims 1 and 4-17 has been withdrawn.
5. See further rejections that follow.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner would like to point out that where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so

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as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). In addition, the Applicant fails to meet the requirements of redefining a term as set forth in the MPEP § 2106. In order to define/redefine a term, the Applicant must do so “with reasonable clarity, deliberateness, and precision” and must “set out his uncommon definition in some manner within the patent disclosure” so as to give one of ordinary skill in the art notice of the change” in meaning. The term “certificate” in claims 1-19 is used by the claim to mean, “an identifier to indicate that a file is virus-free,” while the accepted meaning is “An attachment to an electronic message used for security purposes. The most common use of a digital certificate is to verify that a user sending a message is who he or she claims to be, and to provide the receiver with the means to encode a reply.” The term is indefinite because the specification does not clearly redefine the term.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
9. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

10. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1 and 4-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 09/728,989. Although the conflicting claims are not identical, they are not patentably distinct from each other because MPEP § 2144.04 states that it only requires routine skill in the art to eliminate an element and its function, such as the cache table, and duplicate a part for multiple effect, in this case multiple virus-free certificate authorities.

12. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claim 1 of the instant application reads as follows:

1. A method for use in a virus-free certificate proxy, of retrieving from one or a plurality of virus-free certificate authorities a virus-free certificate certifying that a file is virus-free, said method comprising the steps of:

receiving a virus-free certificate request for a file;

selecting a virus-free certificate authority having authority to generate a virus-free certificate for the file;

requesting the virus-free certificate to the selected virus-free certificate authority;

receiving from the selected virus-free certificate authority the generated virus-free certificate; and

sending back in response to the virus-free certificate request the received virus-free certificate; and

wherein the virus-free certificate request comprises:

a list of one or a plurality of anti-virus programs to execute on the file to determine whether the file is virus-free or not, and

the file for which the virus-free certificate is requested.

14. Claims 1-3 of Application No. 09/728,989 read as:

1. A method, for use in a virus-free certificate cache, of caching one or multiple virus-free certificates, each virus-free certificate certifying that a file is virus-free, said method comprising the steps of:

receiving a virus-free certificate request for a file;

identifying the file in a cache table, said cache table comprising for each identified file one or a plurality of virus-free certificates;

selecting in the cache table one virus-free certificate for the identified file, using one or a plurality of anti-virus certificates;

retrieving from the cache table said selected virus-free certificate;

sending back in response to the virus-free certificate request the retrieved virus-free certificate.

2. The method according to claim 1, wherein the virus-free certificate comprises:

a list of one or a plurality of anti-virus programs to execute on the file to determine whether the file is virus-free or not.

3. The method according to claim 1, wherein the virus-free certificate request further comprises:

an identification of the file.

***Allowable Subject Matter***

15. The following is an examiner's statement of reasons for allowance:

As per claims 1 and 15-17, there are many well-known methods in the prior art for obtaining a certificate comprising the steps of:

receiving a certificate request for a file;  
selecting a certificate authority having authority to generate a certificate for the file;  
requesting the certificate to the selected certificate authority;  
receiving from the selected virus-free certificate authority the generated virus-free certificate; and  
sending back in response to the certificate request the received certificate.

16. There are no teachings in the prior art of a virus-free certificate for a file, wherein the virus-free certificate requests comprises a list of one or a plurality of anti-virus programs to execute on the file to determine whether the file is virus-free or not, and the file for which the virus-free certificate is requested. Since no teachings or motivation can be found of virus-free certificates for a file, wherein the virus-free certificate requests comprises a list of one or a plurality of anti-virus programs to execute on the file to determine whether the file is virus-free

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or not, and the file for which the virus-free certificate is requested, claims 1-17 are therefore novel and non-obvious.

17. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792.

The examiner can normally be reached on Monday thru Thursday 7-5.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner  
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clf

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*Primary Examiner*